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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,077	12/14/2001	James L. Filson	353 USF	7531

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[REDACTED] EXAMINER

CINTINS, IVARS C

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1724 10

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>10/017,077</b>	Applicant(s) <b>Filson et al.</b>
	Examiner <b>Ivars Cintins</b>	Art Unit <b>1724</b>
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Aug 19, 2002 and Sep 23, 2002</u> .		
2a) <input checked="" type="checkbox"/> This action is FINAL.      2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>12-19</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>12-19</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

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The disclosure is again objected to because the first sentence of the specification following the title fails to contain a reference to Applicant's parent application (i.e. Serial No. 09/113,982, filed July 10, 1998, now U.S. Patent No. 6,346,195), as required by 37 C.F.R. § 1.78(a)(2). Also, the relationship between this application and the parent application (i.e. a division) must be indicated, as further required by 37 C.F.R. § 1.78(a)(2).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-16 are again rejected under 35 U.S.C. 102(b) as being anticipated by Faylor et al. (U.S. Patent No. 3,870,033; hereinafter "Faylor"). As pointed out in the previous Office Action, Faylor discloses a system comprising a carbon bed, and an ion exchange unit positioned downstream from the carbon bed; and this is all that is required by apparatus claims 12-16.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-19 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Faylor in view of Katzakian et al. (U.S. Patent No. 3,928,192; hereinafter "Katzakian"). As pointed out in the previous Office Action, Faylor discloses the claimed invention with the exception of the type of ion exchange resin employed. Katzakian discloses an ion exchange resin of the type recited; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the ion exchange resin of Katzakian for the ion exchange resin of the primary reference, since this secondary reference ion exchange resin is capable of removing ions from a liquid in substantially the same manner as the ion exchange resin of the primary reference, to produce substantially the same results.

Applicant's arguments filed August 19, 2002, and supplemented on September 23, 2002, have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that Faylor does not anticipate claims 12-16 because "claims 12-16 require treating a wastewater feed containing metal ions in solution, which is nowhere taught or

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suggested in Faylor." Applicant should note, however, that claims 12-16 are apparatus, not method, claims. Accordingly, these claims merely require a carbon bed, and an ion exchange unit arranged to receive the product stream from the carbon bed. Faylor clearly shows such an arrangement (see Fig. 2; elements 42 and 52). Applicant should further note that apparatus claims 12-16 do not require the treatment of any specific wastewater stream, since the intended use of a device is not a structural limitation, and hence cannot be relied upon to patentably distinguish apparatus claims. It is well settled that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant also argues that there is no motivation to combine the Faylor and Katzakian references. Again, this argument has been noted and carefully considered, but is not deemed to be persuasive of patentability. It is pointed out that the Faylor system clearly requires the presence of a cation exchanger (see col. 6, line 9); and it is further pointed out that Katzakian clearly discloses a cation exchanger of the type recited (see

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col. 5, last line through col. 6, first line). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cation exchanger of Katzakian for the cation exchanger of the Faylor, since this secondary reference cation exchanger is capable of removing cations from a liquid in substantially the same manner as the cation exchanger of the primary reference, to produce substantially the same results.

Applicant further argues that even if the Faylor and Katzakian references could be combined, "one would not have come up with Applicant's invention as claimed of a novel process and apparatus for the removal of copper ions ..." (page 7, lines 8-21, of the response filed August 19, 2002). Once again, this argument has been noted and carefully considered, but is not deemed to be persuasive of patentability, since Applicant is again attempting to improperly incorporate intended use as a limitation in an apparatus claim.

Applicant also notes that Faylor utilizes a variety of filtration devices, which are not required in Applicant's system. It is pointed out, however, that since claim 12 recites "comprising" language (see line 2), these additional treatment devices are not precluded by this claim, nor any of its dependent claims.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached at (703) 308-1972.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for

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all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

*Ivars Cintins*  
**Ivars C. Cintins**  
**Primary Examiner**  
**Art Unit 1724**

I. Cintins  
December 15, 2002